

REMARKS

Claims 1-26 are pending. New claims 14-26 are directed previously unrecited subject matter as disclosed throughout the original specification, for example at first paragraph of page 6 through the middle of page 8. No new matter has been entered.

I. 35 USC § 112

Claims 1-13 stand rejected under 35 USC § 112, second paragraph, as allegedly being unpatentable for failing to particularly point out and distinctly claim that which is considered the invention. In response, claims 1 and 4 have been amended to remove any lack of antecedent basis.

II. Claim 6

Claim 6 stands objected to under 37 CFR § 1.75(c), as allegedly being of improper dependent form. The Office Action asserts that claim 6 fails to further limit the claim from which it depends. In response, claim 6 has been amended to depend from claim 2.

III. Mckee

Claims 1, 3, 4 and 6-13 stand rejected under 35 USC §102(b) as allegedly being anticipated by Mckee (U.S. Patent No. 5,568,391), and claims 2 and 5 are rejected under 35 USC § 103(a) as allegedly being unpatentable over the same reference. The Office Action asserts that Mckee teaches or renders obvious each feature recited by the rejected claims.

However, in light of the amendments made herein, Applicants respectfully present that Mckee does not disclose or suggest each feature of the pending claims. Specifically, claim 1 (from which each of claims 2-13 depend) describes the surface elements as having “edges suited for joining” to allow, for example, a tongue-and-groove joint between adjacent surface elements. In contrast, the ceramic tiles of the cited reference are held together by a mesh of high-melting-point wire or other type of metal screen or expanded foil embedded in the tiles themselves. This

wire or screen is designed to be used both during manufacture and installation of the tiles. See column 4, lines 3-13.

Not only is there no teaching to include edges suitable for joining on the tiles of Mckee, this reference actually teaches away from such a modification. According to the manufacturing method disclosed by the reference, a clay sheet is formed with the metal wire imbedded therein. Through, for example, a cutting nozzle, the tiles are cut from the moist clay. However, the cutting nozzle does not remove the tiles from the metal wire. Thus, the cut tiles are all attached to the same metal wire mesh. According to the reference, such a design allows for simple handling during cutting, firing, glazing, coating, labeling, packing, shipping, unpacking and installation. As a result, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to destroy the wire holding the tiles together as taught by the reference, to thereafter, modify the tiles by providing edges for joining, only to then rejoin the tiles, as such a process is counterintuitive.

Moreover, Applicants respectfully present that the Office Action has mischaracterized the tiles of Mckee. Specifically, the Office Action asserts that “Mckee teaches the use of printed tiles”. However, the reference does not discuss “printing” onto the tiles. While a device “similar to an ink jet printer” is disclosed at column 3, lines 59-60, this description is merely a comparison to the “mechanical raster device similar to an ink jet printer” (emphasis added) used to cut the tiles from the clay. Thus, the mechanical raster device does not print on the tiles. In fact, it is through the cutting devices that the designs desired by Mckee are achieved.

Applicants respectfully present that Mckee does not expressly anticipate any of the rejected claims.

IV. Gerber

A. 35 USC § 102

Claims 1, 3, 4 and 6-13 stand rejected under 35 USC §102(b) as allegedly being anticipated by Gerber (U.S. Patent No. 5,443,680). The Office Action asserts that Gerber teaches each feature recited by the rejected claims. However, as was discussed with reference to McKee above, claim 1 (from which each of claims 3, 4 and 6-13 depend) presently describes the surface elements as having “edges suited for joining” to allow, for example, a tongue-and-groove joint between adjacent surface elements.

In contrast, the tiles of Gerber are, adhered directly to a surface below the tiles. Thus, the tiles are not joined to each other.

Applicants respectfully present that Gerber does not expressly anticipate any of the rejected claims.

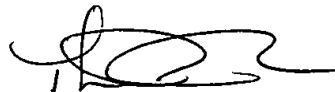
B. 35 USC § 103

Claim 2 stands rejected under 35 USC § 103(a) as allegedly being unpatentable over Gerber in view of Newton et al. (U.S. Patent No. 5,054,559). The Office Action asserts that Gerber teaches each feature taught by claim 2, except for “printing the pattern”, for which purpose Newton et al. is cited. Even if Newton et al. did teach the feature as stated by the Office Action, as this reference fails to teach edges suitable for joining, such as a tongue-and-groove configuration, Applicants respectfully present that Newton et al. does not cure the deficiencies of Gerber alone, as discussed in Section IV.A above. Thus, Applicants respectfully submit that the cited combination of Newton et al. and Gerber cannot render claim 2 obvious.

V. Conclusion

In view of the above, it is respectfully submitted that all objections and rejections are overcome. Thus, a Notice of Allowance is respectfully requested.

Respectfully submitted,



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